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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,758	12/04/2001	Donald J. Monroe	10541-636	8286

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EXAMINER

RODRIGUEZ, PAMELA

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,758

Applicant(s)

MONROE ET AL.

Examiner

Pam Rodriguez

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-17,19-21,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-17,19-21,34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment filed February 4, 2004 has been received and considered.

Claim Objections

2. Claims 15 is objected to because of the following informalities: in the last line of Claim 15, the word "so" should be deleted. Appropriate correction is required. (Note: applicant's remarks in his amendment stated that this correction had been made, but no amendments to this effect were found by the examiner, therefore, the objection has been maintained).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 9-17, 19-21, 34, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnston.

Regarding Claim 1, Johnston discloses a pinion 14/18 moveable along an output shaft 10 of a starter assembly (see Figures 1 and 2) having all the features of the instant invention including: the pinion 14/18 having an inner surface 24 disposed about the output shaft 10 (see Figures 1 and 2, wherein since bushing 18 is integral with pinion

14, the inner surface is readable as the inner surface 24 of pinion bushing 18), the inner surface extending to an end face of the pinion 14/18 (see Figure 1, wherein the bushing inner surface 24 extends to the end faces 22 of the pinion bushing 18), wherein the pinion 14/18 comprises a primary edge (see Figure 2 and the middle groove 20, wherein the primary edge is readable as the right top edge of that groove nearest the top lead line of element numeral 24) for moving particles from the shaft 10 as the pinion 14/18 moves along the output shaft (see column 3 lines 6-13), the primary edge being formed along a length of the inner surface (see Figure 2) and extending to the end face 22 (see Figure 2), the primary edge defining a groove 20 in which the particles are received as the pinion 14/18 moves along the output shaft (see column 3 lines 6-13), and wherein the groove 20 is formed along the length of the inner surface 24 and adjacent the primary edge (see Figure 2).

Regarding Claim 2, Johnston further discloses that the pinion 14/18 is a one-piece pinion (readable as such, since in column 1 lines 67-68, the pinion 14 and bushing 18 are press-fit together and move together, thus the two parts are integral, and form a one-piece structure).

Regarding Claim 3, see column 1 line 58 – column 2 line 1.

Regarding Claim 4, see column 1 lines 58 et al.

Regarding Claim 5, Johnston further discloses a secondary edge for moving the particles from the primary edge, the secondary edge being radially formed on the end face adjacent the primary edge (see Figure 2 and the middle groove 20, wherein the

secondary edge is readable as the right bottom edge of that groove nearest the bottom lead line of element numeral 24).

Regarding Claim 6, see column 3 lines 6-13.

Regarding Claim 7, see Figure 2.

Regarding Claim 9, see the plurality of grooves 20 on the inner surface 24 shown in Figure 2 and note how each groove has its own separate primary edge as described in Claim 1 above.

Regarding Claim 10, see grooves 20 in Figure 2, each formed along the length of the inner surface 24 and adjacent each respective primary edge.

Regarding Claim 11, see Figure 2.

Regarding Claim 12, see Figure 2.

Regarding Claim 13, note how at least bushing 18, which is integral with pinion 14, is made of metal as disclosed in column 2 lines 6-7.

Regarding Claim 14, see the barrel portion shown in Figure 1 and a gear portion (see Figure 1 and the portion of pinion 14/18 labeled element numeral 14), wherein the end face and the inner surface 24 are adjacent the gear portion (see Figures 1 and 2).

Regarding Claim 15, see Claims 1 and 11 and note the bore of bushing 18 being readable as the bore of the inner surface 24.

Regarding Claim 16, see Claim 5 above.

Regarding Claim 17, see groove 20 of Figure 2 and column 3 lines 6-13.

Regarding Claim 19, see Figure 2 and grooves 20.

Regarding Claim 20, see Claim 10.

Regarding Claim 21, see Figure 2.

Regarding Claim 34, pinion assembly 14/18 is readable as being one-piece as the bushing portion 18 is press fitted to the pinion 14 and thus these elements can be said to be integral, i.e., one piece. See also column 1 lines 67 and 68 and column 2 line 1 where the reference teaches that these two components due to their press fitting move together as a "unit" and thus can be constituted as being one-piece.

Regarding Claim 35, Johnston discloses a pinion 14/18 moveable along an output shaft of a starter assembly (see Figures 1 and 2) having all the features of the instant invention including: the pinion 14/18 having an inner surface 24 disposed about the output shaft 10 (see Figures 1 and 2, wherein since bushing 18 is integral with pinion 14, the inner surface is readable as the inner surface 24 of pinion bushing 18), the inner surface extending to an end face of the pinion 14/18 (see Figure 1, wherein the bushing inner surface 24 extends to the end faces 22 of the pinion bushing 18), the end face being substantially perpendicular to the inner surface 24 (see Figure 1, where when the end face of the pinion is defined to be portion 22 of the pinion bushing 18, at least the thickness of that end face 22 is perpendicular to the inner surface 24) wherein the pinion 14/18 comprises a primary edge (see Figure 2 and the middle groove 20, wherein the primary edge is readable as the right top edge of that groove nearest the top lead line of element numeral 24) for moving particles from the shaft 10 as the pinion 14/18 moves along the output shaft (see column 3 lines 6-13), the primary edge being formed along a length of the inner surface (see Figure 2) and extending to the end face 22 (see Figure 2), the primary edge defining a groove 20 in which the particles are

received as the pinion 14/18 moves along the output shaft (see column 3 lines 6-13), and wherein the groove 20 is formed along the length of the inner surface 24 and adjacent the primary edge (see Figure 2).

Response to Arguments

5. Applicant's arguments filed February 4, 2004 have been fully considered but they are not persuasive.

Applicant's main point of contention with the examiner's outstanding office action is that the Johnston reference does not disclose a primary edge extending to an end face of the pinion, wherein, in applicant's REMARKS, he has defined the end face to be the face perpendicular to the inner surface 24 and located near the arrow of element 18 in Figure 2 of the reference.

While applicant has attempted to more clearly define the location of his end face in new Claim 35 and in his remarks, the Johnston reference still teaches this limitation. As discussed in the rejection above, when the pinion assembly is defined to be comprised of portions 14 and 18, due to bushing 18 being press-fit within pinion 14, the inner surface is defined as face 24, shown in Figure 2 of the reference. This inner surface 24 extends to an end face of the pinion, i.e., a surface of bushing portion 18 readable as an end face portion. This end face that inner surface 24 extends thereto, as described by applicant and as agreed upon by the examiner, is that face of chamfered portions 22. Along these same lines, the primary edge of groove 20, defined above, also extends to this same end face portion 22. Therefore, if end face portion 22

is defined to be the "end face" of applicant's claim language, the primary edge does extend to this portion of the pinion assembly. Further, since the thickness of this end face 22 is located substantially perpendicular to the inner surface 24, portion 22 also meets this limitation of the claim.

It is for these reasons that the rejections have been maintained.

Conclusion


6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pam Rodriguez whose telephone number is 703-308-3657. The examiner can normally be reached on Mondays 6 am -4 pm and Tuesdays 6 am -12 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pam Rodriguez
Primary Examiner
Art Unit 3683
4/6/04

PR
04/06/2004